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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,118	06/07/2001	Kulvir Singh Bhogal	AUS9200010352US 1	1243

7590

10/06/2004

Cynthia S. Byrd
IBM Corporation
11400 Burnet Rd.
Austin, TX 78758-5884

EXAMINER

COLLINS, SCOTT M

ART UNIT

PAPER NUMBER

2145

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/876,118	Applicant(s) BHOGAL ET AL.	
	Examiner Scott M. Collins	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-12 examined.
2. It is hereby acknowledged that the following papers have been received and placed of record in the file: Formal Drawings on 03/15/2004.

Drawings

3. The drawings were received on 03/15/2004. These drawings are acceptable.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Beck et al., U.S. Patent Number 5,903,723 (herein referred to as Beck).
6. Referring to claims 1, 5, and 9, Beck has taught a distributed computer system including a server and a client, the server including a message store, a method (or a computer program product having computer code on a computer readable medium) for delivering Web content within a body section of electronic mail messages (Beck figure 6) comprising:
 - a. receiving at a server, at least one mail message containing an embedded hyperlink (Beck column 5, lines 6-33);
 - b. downloading Web content associated with the hyperlink into the message store at the server (Beck column 5, lines 6-33); and

c. transmitting the mail message and the corresponding Web content for display at the client (Beck column 5, lines 6-33).

7. Referring to claims 2, 6, and 10, Beck has taught the method (or product) further comprising:

a. detecting, at the server, plurality of incoming mail messages containing a common hyperlink (Beck column 5, line 34 – column 6, line 12; column 8, line 56 – column 9, line 16);

b. tagging each incoming mail message containing the common hyperlink (Beck column 5, line 34 – column 6, line 12; column 8, line 56 – column 9, line 16);

c. storing one copy of the Web content associated with the common hyperlink in the message store at the server (Beck column 5, line 34 – column 6, line 12; column 8, line 56 – column 9, line 16); and

d. parsing the hyperlink when a tagged message is sent to the client (Beck column 5, line 34 – column 6, line 12; column 8, line 56 – column 9, line 16).

8. Referring to claims 3, 7, and 11, Beck has taught the method (or product) further comprising compressing Web content that exceeds a predetermined size, at the server (Beck column 6, lines 38-60).

9. Referring to claims 4, 8, and 12, Beck has taught the method (or product) further comprising:

a. determining whether the client has a preset time for downloading messages containing Web content (Beck column 13, lines 31-39); and

b. in response to determining that a preset time for downloading Web content exists, caching the message and Web content at the server until the preset time is reached (Beck column 13, lines 31-39).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- | | | |
|----|----------------|---|
| a. | Costales et al | U.S. Patent Number 6,044,395 |
| b. | Birrell et al. | U.S. Patent Number 6,009,462 |
| c. | Bates et al. | U.S. Patent Number 6,769,015 |
| d. | Paleiov et al. | U.S. Patent Application Number US 2002/0138586 A1 |

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott M. Collins whose telephone number is 703.305.7865. The examiner can normally be reached on Mon.-Fri. 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on 703.308.5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

smc
September 20, 2004


DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100